

REMARKS

Claims 1-5 are pending in this application. By this Amendment, claims 1 and 2 are amended. Support for the amendments is found, for example, in paragraphs [0034] and [0023], respectively. No new matter is added.

Applicants claim foreign priority under 35 U.S.C. §119 to Japanese Application No. 2003-047329 filed February 25, 2003. A certified copy of the foreign application was filed February 5, 2004. However, the Office has yet to acknowledge the perfection of the claim to priority. Applicants respectfully request the Office acknowledge the claim to priority or indicate its deficiencies so that Applicants may properly perfect priority.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action rejects claim 2 under 35 U.S.C. §112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. Applicants amend claim 2, as recited above, to particularly point out and distinctly claim the subject matter of the invention as recited in the claim and supported by the specification. Therefore, Applicants respectfully request withdrawal of the rejection.

Initially, Applicants stress the following requirements for a 35 U.S.C. §102 rejection.

1) In order to anticipate a claim, all features or limitations of a claim must be disclosed in a single reference either explicitly or inherently. 35 U.S.C. §102. See also, In re Paulsen, 30 F.3d 1475, 1478,1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

2) All positively recited features of a claim must be addressed in an Office Action. In re Angstadt et al., 190 USPQ 214 (CCPA 1976); In re Alul et al., 175 USPQ 700 (CCPA 1972) and General Electric Company v. U.S., 198 USPQ 65 (US Cl.Ct 1978).

3) When rejecting a claim based on prior art, the Examiner must designate the particular part of the reference relied on as nearly as practicable. 37 C.F.R. §1.104(c)(2).

The Office Action has failed to meet any of the above requirements in asserting the below rejections. First, the below rejections simply allege anticipation of the features of claims 1-5. Second, the below rejections fail to address all of the positively recited features of claims 1-5. Third, the below rejections fail to indicate the portions of the applied references relied on as disclosing the features of the claims 1-5.

In view of at least the forgoing, the below rejections fail to meet the basic requirements of a 35 U.S.C. §102 rejection and are improper. Because the below rejections are improper, Applicants respectfully request withdrawal of the rejections. However, in order to expedite prosecution, Applicants will address each rejection below, as best understood.

The Office Action rejects claim 1 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Japanese Patent Publication No. 09-183605 (JP '605). Applicants respectfully traverse this rejection.

Applicants continue to assert that JP '605 does not disclose "selectively closing pores having a pore diameter of 20Å or less," as recited in claim 1. Instead, JP '605 discloses

adsorbing a low boiling point hydrocarbon onto the inner surface of the pores on the activated carbon as shown in Figure 1. The low boiling point hydrocarbon 4 adsorbs to the inner surface of the pores 31 to prevent the high boiling point hydrocarbon 5 from adsorbing to the active carbon 3. This allows the otherwise hard to desorb high boiling point hydrocarbon 5 to easily desorb from the low boiling point hydrocarbon 4 rather than hardly desorbing from the activated carbon 3. Importantly, Figure 1(a) shows the entire inner surface of the pore 31 of the activated carbon 3 covered by the low boiling point hydrocarbon; but not blocking the pore itself opening. This allows the high boiling point hydrocarbon 5 to access inner surface area of the pore 31. Because JP '605 discloses using the low boiling point hydrocarbon 4 to cover the inner surface of the pore 31, it does not disclose "selectively closing pores having a pore diameter of 20Å or less," because none of the pores are blocked or closed. Thus, JP '605 fails to disclose all the features recited in claim 1, and Applicants respectfully request withdrawal of the §102 rejection.

The Office Action rejects claims 1-3 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Japanese Patent Publication No. 62-132543 (JP '543). Applicants respectfully traverse this rejection.

With respect to claim 1, JP '543 does not disclose "selectively closing pores having a pore diameter of 20 Å or less," as recited in claim 1. Instead, JP '543 discloses depositing phthalocyanine at a temperature between 350 to 750 °C to produce a mean pore size of less than or equal to 10Å. This is not equivalent to closing all pores with a diameter less than 20Å, as recited in claim 1. Therefore, JP '543 does not recite all the features in the above-identified application.

Additionally, Applicants assert claim 2 is patentable, at least in view of the patentability at least in view of the patentability of claim 1, from which it depends, as well as

the additional features it recites. Therefore, Applicants request the withdrawal of the §102 rejection.

Claim 3 is patentable, at least in view of the patentability of claim 1, from which it depends, but also for specifically reciting "wherein the activated carbon is heated after the organic compound is adsorbed onto the activated carbon." JP '543 discloses heating the phthalocyanine compound while depositing onto the activated carbon (JP' 543 Abstract). Thus, JP '543 does not disclose heating the activated carbon "after the organic compound is absorbed onto the activated carbon" because it discloses heating the activated carbon during adsorption. This allows for leaving the organic compound in pores below 20Å (Specification [0024]). Therefore, Applicants request the withdrawal of the §102 rejection.

The Office Action rejects claims 1-5 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,458,022 (Ohsaki). Applicants respectfully traverse this rejection.

With respect to claim 1, Ohsaki does not disclose "adsorbing an organic compound which is the same as naphthalene, or whose boiling point is higher than that of naphthalene," as recited in claim 1. Rather, Ohsaki discloses decomposing coal tar into carbon particles by heat treatment (Ohsaki col. 4 lines 38-39). Further, the carbon is deposited on the activated carbon to grow a carbon crystallite through mesophase on the inner surface of the micropore (Ohsaki col. 4 lines 40-41). This is not the same as "adsorbing an organic compound" because carbon is an element and not an organic compound. Additionally, the carbon is not adsorbing to the activating carbon but is rather aggregating into a carbon crystallite through mesophase, thereby altering the character and structure of the activated carbon (Ohsaki col. 4 lines 40-41). Thus, Ohsaki does not recite " adsorbing an organic compound which is the same as naphthalene, or whose boiling point is higher than that of naphthalene." Therefore, Applicants request the withdrawal of the §102 rejection.

Applicants assert that claims 2-5 are patentable, at least in view of the patentability of claim 1, from which they variously depend, as well as for the additional features they recite. Accordingly, Applicants request withdrawal of the §102 rejection to claims 2-5.

The Office Action rejects claims 1-3 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,962,129 (Munzner). Applicants respectfully traverse this rejection.

With respect to claim 1, Munzner does not disclose "closing pores having a pore diameter of 20Å or less." Rather, Munzner discloses reducing the cross-section of the pores of the activated carbon that are too large to act as a molecular sieve to diameters of approximately 0.2 to 0.6 millimicrons, which corresponds to 2 to 6 Å (Munzner col. 2 lines 17-20). This does not disclose nor is it equivalent to closing pores that are 20Å or less because it does not disclose closing pores. Therefore, Applicants request the withdrawal of the §102 rejection.

Applicants assert that claims 2 and 3 are patentable, at least in view of the patentability of claim 1, from which they variously depend, as well as for the additional features they recite. Accordingly, Applicants request withdrawal of the §102 rejection to claims 2 and 3.

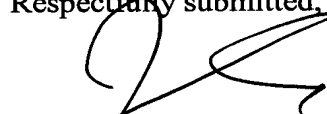
With respect to the alternative §103 rejections, the obviousness rejections of claims 1-5 are not supported with a clear and explicit articulation of the reasons why the claimed invention allegedly would have been obvious (including a reasonable rationale as to why the references would have been modified) as required in the MPEP §§2141(III) and 2142. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR International Co. v. Teleflex, Inc., 550 U.S. ___, 82 USPQ2d 1306 (2007). The Office Action merely provides broad and ambiguous statements in

alleging the above-identified application would be obvious in view of the references stated above. In response to the remarks of Applicants amendment filed August 23, 2007, the Office Action states "[t]he other references appear to achieve the claimed effect, due to the similarity of the process" (Office Action page 3). The Office Action further states, "[i]t is argued that [JP] '605 that [sic] no pores of 20A diameter remain" and continuously states "[n]o differences are seen in the carbon or the effect of the treatment." However, the Office Action does not particularly point out the portions of the references that are equivalent or provide an articulated reasoning with some rational underpinning to support the allegations of obviousness. Therefore, Applicants request the withdrawal of the §103 objections to claims 1-5.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-5 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Petition for Extension of Time

Date: February 29, 2008

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